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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/875,208

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Yoichi Okudera

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10/30/2006

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/875,208	Applicant(s) OKUDERA, YOICHI	
	Examiner Jeffrey R. Swearingen	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 12, 14-26, 28 and 31-44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8, 10, 12, 14-26, 28 and 31-44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/6/2006 have been fully considered but they are not persuasive.
2. In response to applicant's arguments, the recitation "the old address having been changed to the new address" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
3. The old address in Lee is the address that the received email is sent to – the Switchboard. Column 7, line 26-35. The new address is after the user releases the address to the "inquirer." The database in Lee identifies the user with an email address that he can have information sent to. The "old address" or Switchboard address searches the database and finds the relational record for that user that contains a new email address to send to the user. The user releases the information by selecting whether to send the email address, or a means for making the changer confirm whether the new address disclosed when the address disclosing condition in searching includes the set condition and a means for informing the inquirer of the new address when the change permits the disclosure of the new address.
4. The Lee patent fulfills Applicant's claim language exactly.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-10, 12, 14-28, and 31-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (U.S. Patent No. 5,742,769).

7. In regard to claim 1, Lee disclosed *a data base relationally storing at least the old address, the new address, and an address disclosing condition capable of setting a condition whereby the changer judges whether to give permission to disclose the new address based on attribute information about the inquirer*; (column 4, line 63 – column 5, line 6; column 6, lines 33-67; column 7, lines 1-50) *a means for searching the new address corresponding to the old address and the address disclosing condition from the data base when the inquirer sends an inquiry including the old address*; (column 7, lines 36-50) *a means for making the changer confirm whether the new address is disclosed when the address disclosing condition in searching includes the set condition*; (column 7, lines 36-50) *and a means for informing the inquirer of the new address when the changer permits the disclosure of the new address*. (column 7, lines 45-50).

8. In regard to claim 2, Lee disclosed *the data base includes a list of specific inquirers who are refused inquiries about the new address, the system, further comprising a means for refusing an inquiry from the inquirer included in the list*. (column 5, lines 42-65; column 6, lines 1-7; column 6, lines 48-67)

9. In regard to claim 3, Lee disclosed *the data base relationally stores a plurality of old addresses and one new address*. (column 6, lines 16-19).

10. In regard to claim 4, Lee disclosed *the address disclosing condition is allowed to be set on each of the plurality of old addresses in the data base*. (column 6, lines 16-47)

11. In regard to claim 5, Lee disclosed *the old address and the new address each include at least one sort out of an electronic mail address, a home page address, a telephone number, an address, and a residence*. (column 3, lines 1-5; column 5, line 33; column 6, lines 16-21)

12. In regard to claim 6, Lee disclosed *a means for informing the inquirer of the new address of a predetermined sort according to the sort of the old address included in the inquiry sent from the inquirer*. (column 7, lines 36-50)

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13. In regard to claim 7, Lee disclosed *a means for sending the message text to make the changer confirm whether the new address is disclosed according to the selection of the changer.* (column 7, lines 36-50)

14. In regard to claim 8, Lee disclosed *an address data base, in which a registrant registers his or her own address, relationally storing an address disclosing condition for an inquirer who wishes to know the address of the registrant;* (column 4, lines 63 – column 5, line 6; column 6, lines 33-67; column 7, lines 1-50) *a disclosure judging means for judging whether to disclose the address to the inquirer based on the address disclosing condition when the inquirer makes an inquiry about the address of the registrant;* (column 6, line 48-67) *and an address disclosing means for disclosing the address of the registrant to the inquirer if the disclosure judging means judges that the address is disclosed, wherein the disclosing condition includes information about inquirers to whom the address is disclosed or not disclosed, wherein the disclosure means includes a confirming means for making the registrant confirm whether the address is disclosed to the inquirer when the inquirer who inquires about the address is not registered in the inquirers in the disclosing condition, and wherein the confirming means informs the registrant of the attribute information about the inquirer at the time of confirmation.* (column 7, lines 1-50)

15. In regard to claim 9, Lee disclosed *the address data base stores one, or two or more old addresses of the registrant, and wherein the disclosure judging means receives the old address of the registrant in the inquiry about the address of the registrant from the inquirer and acquires the address disclosing condition of the registrant by searching the address data base with this old address.* 9column 6, lines 16-21; column 7, lines 1-50)

16. In regard to claim 10, Lee disclosed *the address data base stores attribute information about the registrant, and wherein the disclosure judging means makes the inquirer select a registrant about whose address an inquiry is made by presenting at least a part of the attribute information about a plurality of registrants when the plurality of registrants are searched with respect to the old address.* (column 5, line 28 – column 6, line 67)

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17. In regard to claim 12, Lee disclosed *the information about the inquirers to whom the address is disclosed or not disclosed includes information that the address is disclosed or not disclosed to all of the inquirers or only a part thereof.* (column 6, lines 16-67)
18. In regard to claim 14, Lee disclosed *a profile of the inquirer.* (column 6, lines 48-54)
19. In regard to claim 15, Lee disclosed *an inquirer attribute information storing means for previously storing the attribute information about the inquirer;* (column 6, lines 50-54) *and an inquirer attribute information registering means for accepting registration of the attribute information from the inquirer when the attribute information of the inquirer is not stored by the inquirer attribute information storing means.* (column 6, lines 50-54)
20. In regard to claim 16, Lee disclosed *the confirming means allows a part or all of a message to the registrant received from the inquirer to be sent to the registrant.* (column 7, lines 9-12)
21. In regard to claim 17, Lee disclosed *the confirming means includes a disclosing condition registering means for receiving a confirmation result from the registrant and registering the inquirer in the disclosing condition as an inquirer to whom the address is disclosed or not disclosed.* (column 7, lines 26-50)
22. In regard to claim 18, Lee disclosed *the disclosure judging means refuses to disclose the address to the inquirer when a response to a confirmation requested by the confirming means is not obtained from the registrant before a predetermined deadline.* (column 7, lines 1-50)
23. In regard to claim 19, Lee disclosed *a means for informing the registrant that the inquirer made the inquiry about the address.* (column 7, lines 26-35)
24. In regard to claim 20, Lee disclosed *the address is an electronic mail address.* (column 7, lines 26-35)
25. In regard to claim 21, Lee disclosed *the address is a home page address.* (column 8, lines 1-12; "business address")
26. In regard to claim 22, Lee disclosed *the address is a telephone number or an address/residence.* (column 8, lines 1-12)

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27. In regard to claim 23, Lee disclosed *a storage medium; and an inquiry instructing means, stored in the storage medium and started based on the return of an electronic mail because its destination is unknown, for instructing the computer system to inquire of the system for making the inquiry about the address about an electronic mail address of an addressee of the electronic mail.* (column 7, lines 1-50)

28. In regard to claim 24, Lee disclosed *a storage medium; and an inquiry instructing means, stored in the storage medium and started based on the impossibility of display of a home page because its destination is unknown, for instructing the computer system to inquire of the system for making the inquiry, about the address about an address of the home page.* (column 7, lines 1-50)

29. In regard to claim 25, Lee disclosed *a home page displaying means for instructing the computer system to display the home page concerned in the address based on the disclosure of the address by the system for inquiring about the address.* (column 7, lines 1-50)

30. Claim 26 is substantially the same as claim 8.

31. Claim 27 is substantially the same as claim 9.

32. Claim 28 is substantially the same as claim 10.

33. Claim 31 is substantially the same as claim 14.

34. Claim 32 is substantially the same as claim 15.

35. Claim 33 is substantially the same as claim 16.

36. Claim 34 is substantially the same as claim 17.

37. Claim 35 is substantially the same as claim 18.

38. Claim 36 is substantially the same as claim 19.

39. Claim 37 is substantially the same as claim 20.

40. Claim 38 is substantially the same as claim 21.

41. Claim 39 is substantially the same as claim 22.

42. Claim 40 is substantially the same as claim 23.

43. Claim 41 is substantially the same as claim 24.

44. In regard to claims 42-44, Lee disclosed *the attribute information about the inquirer includes identity information of the inquirer.* (column 6, lines 33-43)

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Adamson et al. US 5,717,863

Waskiewicz US 5,822,526

Kikinis US 6,785,710 B2

Mazieres, David et al. "The Design, Implementation and Operation of an Email Pseudonym Server." Proceedings of the 5th ACM Conference on Computer and Communications Security. San Francisco, CA. ACM Press. pp. 27-36. 1998.

46. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

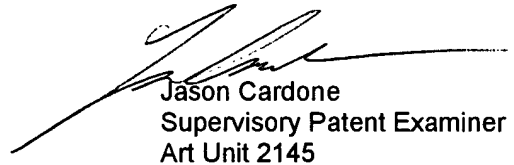
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone
Supervisory Patent Examiner
Art Unit 2145